

Objection to Claim 37

In **paragraph 2** of the Action, claim 37 is objected to as being dependent from a claim which has previously been cancelled. Applicant apologizes for this informality, and has amended the claim as above, to remove the basis for such objection. Accordingly, Applicant respectfully requests that the objection to amended claim 37 be withdrawn.

§103(a) Rejection of Claims 35, 37, 40-63, 70-72 and 79-88

In **paragraphs 3 and 4** of the Action, claims 35, 37, 40-63, 70-72 and 79-88 were rejected as being unpatentable over the Pentikainen reference (USP 6,185,412) in view of the Bilgic reference (5,884,148). In response, Applicant respectfully traverses the rejection of such claims.

In a previous response, Applicant distinguished the Pentikainen reference from, for example, claim 35 in that claim 35 includes the feature of:

enabling receipt of one or more digits of a telephone number from the telephone interface even if no communication channels are available and comparing each of the received digits, as received, against corresponding digits of one or more emergency codes to determine whether a priority channel request is required to facilitate an emergency telephone call, and disabling the receipt of further digits if it is determined that a received digit is not associated with an emergency code (emphasis added)

That is, claim 35 includes the feature of, in the absence of available communication channels, analyzing a received telephone number as individual elements of the telephone number are being entered by the user (i.e., as the number is received, on a number-by-number basis) and, upon detecting a digit element that does not conform to a corresponding digit in an emergency code, the entry of further digits of the telephone number is disabled and the emergency call handling method is abandoned. In this regard, the claimed invention performs a comparison upon receipt

of each digit of a telephone number, as the number is being entered, to determine whether to continue with the emergency call procedure.

At multiple points throughout the Action, the Action asserts that (1) the Pentikainen reference inherently teaches the claimed “comparing each of the received digits, as received, against corresponding digits of one or more emergency codes” using a computer addition or subtraction process (see, e.g., page 4). This claim of inherency is then followed by (2) an acknowledgement that the Pentikainen reference *fails to disclose* the claimed feature of “comparing each of the received digits, as received, against corresponding digits of one or more emergency codes to determine whether a priority channel request is required to facilitate an emergency telephone call”, but that such element is taught by the Bilgic reference. While these two positions seem inapposite to one another, Applicant will traverse each of the bases for rejection in turn, below.

No Inherency

A rejection based on inherency requires that (1) the alleged inherent characteristic *must necessarily* be present, and (2) that the alleged inherent characteristic *necessarily flows* from the prior art reference would be so recognized by one of ordinary skill in the art (see, e.g., *In re Robertson*, 49 USPQ2d 1949 (CAFC 1999); *Continental Can Co. v. Monsanto Co.*, 20 USPQ2d 1746 (CAFC 1991); and MPEP §2112). The foregoing test is not satisfied by what the reference *may teach*, but what *must necessarily be present* (see, e.g., *SGS Thomson Microelectronics v. Int'l Rectifier Corp.*, 32 USPQ2d 1496 (CAFC 1994)). That is to say, in order for a claim element to be inherently taught by a reference, it *must necessarily be present* in the cited reference for the teachings of the reference to work, and that one of ordinary skill in the art would recognize that the claim element is inherent in the teachings of the reference.

In this case, despite the characterization in the Action, Applicant respectfully submits at least the Examiner's assertions that Pentikainen inherently teaches the claimed feature of *comparing each of the received digits, as received, against corresponding digits of one or more emergency codes to determine whether a priority channel request is required to facilitate an emergency telephone call* of, for example, rejected claim 35 fails to meet the foregoing standard. That is, Applicant respectfully asserts that it would not be apparent to one skilled in the art that the Pentikainen reference **must** work in the manner characterized in the Action. As developed above, the fact that the Pentikainen reference **may** work in such a fashion fails to satisfy the established standard for obviousness rejections based on the inherent teachings of a reference.

Not only is the claimed element not inherent in the Pentikainen reference, Applicant has identified specific language within the Pentikainen reference that **actually teaches away** from that which is claimed in rejected claim 35. More particularly, Pentikainen specifically teaches that "the string dialled [sic] into the terminal device is compared with the strings stored in the terminal device and if this comparison indicates that an emergency number is being called, operation is continued" (col. 3, lines 13-17). Those skilled in the art will appreciate that a "string" is defined as a contiguous series of multiple characters, i.e., two or more. Thus, in contradistinction to the claimed invention, Pentikainen discloses a system wherein once the string [i.e., the entire telephone number] is received, a comparison is performed to determine whether the received telephone number (as a whole) corresponds to an emergency number (see, e.g., col. 3, lines 10-18; and col. 4, lines 48-56). Applicant respectfully submits that a reference cannot inherently require a claimed feature when the literal disclosure of the reference actually teaches away from the claimed feature.



In light of the foregoing, Applicant respectfully submits that the Action evidences impermissible hindsight reconstruction, using the claimed invention as a guide, in finding the cited elements of, for example, rejected claim 35 as being inherent in the Pentikainen reference.

Pentikainen in view of Bilgic

As introduced above, the Action acknowledges (e.g., page 5) that the Pentikainen reference fails to disclose comparing each of the received digits, as received, against corresponding digits of one or more emergency codes or a priority channel request”, citing the Bilgic reference as curing such deficiency. Applicant respectfully disagrees.

As Pentikainen, Bilgic specifically discloses “[A]fter receiving the **third dialed number 1009, assuming the local emergency numbering scheme defines a three-digit emergency number code, the URC 104 determines whether or not an emergency number code has been dialed**” (col. 17, lines 15-20). That is, Bilgic specifically discloses entry of an entire emergency number code (e.g., three-digits in one case (911), or more digits if an entire telephone number is required), before a determination is made of whether the entered *digits as a whole (i.e., code or string)* denote an emergency number code. As with the Pentikainen reference, by explicitly requiring that the entire digit sequence be entered before making a determination of whether the entered sequence corresponds to an emergency code **actually teaches away** from that which is particularly claimed in, for example, rejected claim 35.

In this regard, neither the Pentikainen nor the Bilgic reference, alone or in combination, can be read to disclose or suggest that which is claimed in rejected claim 35. Accordingly, Applicant respectfully requests that the §103(a) rejection of claim 35 be withdrawn.

Applicant respectfully submits that analogous arguments can be made which likewise distinguish rejected claims 48, 59, 66 and 79 over the cited references. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

Applicant notes that claims 37, 40-47, 49-58, 60-63, 67, 68, 70-72 and 80-88 are dependent from one of patentable base claims 35, 48, 59, 66 or 79. Thus, in addition to any independent basis of patentability, claims 37, 40-47, 49-58, 60-63, 67, 68, 70-72 and 80-88 are likewise patentable over the Pentikainen and Bilgic references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 37, 40-47, 49-58, 60-63, 67, 68, 70-72 and 80-88 be withdrawn.

§103(a) Rejection of Claims 38, 39, 64, 65, 69, 74, 76, 77 and 90

In **paragraph 5** of the Action, claims 38, 39, 64, 65, 69, 74, 76, 77 and 90 were rejected as being unpatentable over the Pentikainen reference (USP 6,185,412) in view of the Bilgic reference (5,884,148) as applied to claims 35, 37, 48, 59, 68 and 79, in further view of a patent issued to Veerasamy et al (USP 6,208,865) and a patent issued to Gray (USP 6,108,323). In response, Applicant respectfully traverses the rejection of such claims.

Without adopting the characterization of such references found in the Action, and without the need to further characterize the Veerasamy and/or Gray references, Applicant respectfully submits that such references were not cited as curing and do not, in fact, cure the above-referenced deficiencies of the Pentikainen and Bilgic references. Accordingly, Applicant respectfully submits that claims 35, 48, 59, 68 and 79 are patentable over the combination of Pentikainen, Bilgic, Veerasamy and Gray references.

Applicant notes that claims 38, 39, 64, 65, 69, 74, 76, 77 and 90 are dependent on patentable base claims 35, 48, 59, 68 or 79. In this regard, despite any additional independent basis for patentability, claims 38, 39, 64, 65, 69, 74, 76, 77 and 90 are patentable over the cited references by virtue of at least their dependence on such patentable base claims. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 38, 39, 64, 65, 69, 74, 76, 77 and 90 be withdrawn.

§103(a) Rejection of Claims 73, 75, 78 and 89

In **paragraph 6** of the Action, claims 73, 75, 78 and 89 were rejected as being unpatentable over the Pentikainen reference (USP 6,185,412) in view of the Bilgic reference (5,884,148) as applied to claims 35 and 48, in further view of a patent issued to Joong et al (USP 5,937,355). In response, Applicant respectfully traverses the rejection of such claims.

Without adopting the characterization of such references found in the Action, and without the need to further characterize the Joong reference, Applicant respectfully submits that the Joong reference was not cited as curing and does not, in fact, cure the above-referenced deficiencies of the Pentikainen and Bilgic references. Accordingly, Applicant respectfully submits that claims 35, 59, and 79 are patentable over the combination of Pentikainen, Bilgic and Joong references.

Applicant notes that claims 73, 75, 78 and 89 are dependent on patentable base claims 35, 59 or 79. In this regard, despite any additional independent basis for patentability, claims 73, 75, 78 and 89 are patentable over the cited references by virtue of at least their dependence on such patentable base claims. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 73, 75, 78 and 89 be withdrawn.

In addition to the inherency-basis for rejection, the In contradistinction to the foregoing claim feature, the Pentikainen reference and the Bilgic reference each specifically disclose a method wherein an entire number string (i.e., the entire telephone number) is compared against an emergency code once the telephone number is completely entered (see, e.g., Pentikainen col. 3, lines 12-18 and col. 4, lines 48-64; and Bilgic col. 17, lines 1-25 and 34-45).

§103(a) Rejection of Claims 91-93 and 95-99

In **paragraph 7** of the Action, claims 91-93 and 95-99 were rejected as being unpatentable over the Veerasamy reference in view of the Joong reference. In response, Applicant respectfully traverses the rejection of such claims.

Rejected claim 91, for example, includes the feature of:

establishing the emergency telephone call using **a reduced rate communication channel reserved for emergency telephone calls** when traditional communication channels are otherwise unavailable

Without the need to further characterize the Veerasamy reference, the Action acknowledges that the Veerasamy reference fails to disclose or suggest that the priority channel request denotes an emergency call; that the channel is a reduced rate communication channel; or that the reduced rate channel is reserved for emergency telephone calls. The Action cites the Joong reference as curing these deficiencies in the Veerasamy reference. Applicant respectfully disagrees.

The Joong reference merely teaches an emergency call handling system whereby in the absence of an available communication channel to handle an emergency telephone call, the system utilizes short messaging service (SMS) technology to communicate an emergency notification to the base station via **the control channel**. It will be appreciated by those skilled in

the art that the DCC (control channel) is not necessarily a reduced rate channel. The fact that the emergency SMS communication only utilizes a subset of the bandwidth of the control channel does not make the control channel a reduced rate communication channel.

Moreover, the control channel is not reserved for emergency communications. Rather, the control channel is used to facilitate communications between a communication and the one or more subscriber unit(s) in the station's coverage area when the subscriber units are idle (see, e.g., col. 2, lines 32-41; col. 3, lines 1-8 and 59-67; col. 4, lines 7-19). In this regard, Applicant respectfully submits that the Joong reference fails to disclose or suggest that which is claimed in, for example, rejected claim 91. Accordingly, Applicant respectfully requests that the §103(a) rejection of claim 91 be withdrawn.

Applicant respectfully submits that claim 97 includes claim features similar to that of claim 91 and is, in this regard, likewise patentable over the Veerasamy and Joong references for reasons analogous to those presented above with respect to claim 91. Accordingly, Applicant respectfully requests that the §103(a) rejection of claim 97 be withdrawn.

Applicant notes that claims 92, 93, 95, 96, 98 and 99 depend from claims 91 or 97, respectively. Thus, in addition to any independent basis for patentability, Applicant respectfully asserts that claims 92, 93, 95, 96, 98 and 99 are likewise patentable over the Veerasamy and Joong references by virtue of at least their dependence from patentable base claims 91 or 97. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 92, 93, 95, 96, 98 and 99 be withdrawn.

§103(a) Rejection of Claims 94 and 100

In **paragraph 8** of the Action, claims 94 and 100 were rejected as being unpatentable over the Veerasamy reference in view of the Joong reference as applied to claims 91 and 97, in further view of the aforementioned Gray reference. In response, Applicant respectfully traverses the rejection of such claims.

Without adopting the characterization of such references found in the Action, and without the need to further characterize the Gray reference, Applicant respectfully submits that the Gray reference was not cited as curing and does not, in fact, cure the above-referenced deficiencies of the Veerasamy and Joong references. Accordingly, Applicant respectfully submits that claims 91 and 97 are patentable over the combination of Veerasamy, Joong and Gray references.

Applicant notes that claims 94 and 100 are dependent on patentable base claims 91 or 97. In this regard, despite any additional independent basis for patentability, claims 94 and 100 are patentable over the cited references by virtue of at least their dependence on such patentable base claims. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 94 and 100 be withdrawn.

§103(a) Rejection of Claims 101-109

In **paragraph 9** of the Action, claims 101 through 109 were rejected as being unpatentable over a patent issued to Linneweh et al (USP 5,862,485) in view of the Gray reference. In response, Applicant respectfully traverses the rejection of such claims.

Claim 101 includes the feature of:

adjusting a spatial division multiple access (SDMA)
channel reuse pattern of a wireless communication station to free
communication resources to facilitate a telephone call associated

with the priority channel request when other communication channels are not available.

That is, claim 101 is directed to a method for allocating communication resources to service a priority channel request by adjusting a SDMA channel reuse pattern to free communication resources to accommodate the priority channel request when communication resources are not otherwise available. Despite the characterization in the Action, neither the Linneweh nor the Gray references, alone or in combination, disclose or suggest at least this claim element.

Despite the characterization in the Action, the Linneweh reference does not disclose or suggest the “adjusting a channel reuse pattern of a wireless communication station *to free communication resources* to facilitate a telephone call...”. Rather, Linneweh specifically discloses that if a priority channel request is received by a BS without available resources, the BS goes into a reservation state, wherein the BS will begin to reserve communication resources *as they become available* for use in services priority channel requests (see, e.g., col. 3, lines 60-67; col. 4, lines 1-11, lines 29-38 and 52-58). That is, one skilled in the art considering the entire disclosure of Linneweh would appreciate that Linneweh fails to disclose or suggest actively freeing communication resources by adjusting an channel reuse pattern, but merely reserves such channels as they become available in the normal course.

Thus, without adopting the characterization of the Gray reference found in the Action, and without the need to further characterize the Gray reference, Applicant respectfully submits that the Gray reference was not cited as curing and does not, in fact, cure the above-referenced deficiencies of the Linneweh reference. Accordingly, Applicant respectfully submits that claim 101 is patentable over the Linneweh reference in view of the Gray reference.

Applicant respectfully submits that claim 106 enjoys claim features similar to those of claim 101, albeit in accordance with its respective embodiment. Accordingly, Applicant respectfully asserts that claim 106 is likewise patentable over the Linneweh and Gray references using arguments analogous to those presented above with respect to claim 101.

Applicant notes that claims 102-105 and 107-109 are dependent on patentable base claims 101 or 106. In this regard, despite any additional independent basis for patentability, claims 102-105 and 107-109 are patentable over the cited references by virtue of at least their dependence on such patentable base claims. Accordingly, Applicant respectfully requests that the §103(a) rejection of claims 102-105 and 107-109 be withdrawn.

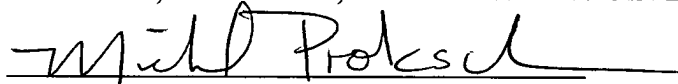
Conclusion

In light of the foregoing amendment and remarks, Applicant respectfully submits that claims 35 and 37-109 are now in condition for allowance and earnestly awaits notice thereof.

Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: January 16, 2002


Michael A. Proksch
Reg. No. 43,021

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 684-6200